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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

10/10/00 10/10/00 10/10/00 10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/725,850

Applicant(s)

Rose

Examiner

Jefferson Evans

Art Unit

2652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 ✓ 20) ☐ Other:

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This Application is a Reissue of Serial No. 08/544,950 filed 10-18-1995, U.S. Patent No. 5,844,757.

Claims 1 to 42 are pending.

1. The drawing sheets filed 11-30-2000 have been approved by a PTO draftsman.
2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. Applicant has filed an offer to surrender the patent but has not yet actually surrendered the patent.
4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: 35 U.S.C. 251 states that the commissioner shall reissue the patent for the invention disclosed in the original patent and that no new matter shall be introduced into the application for reissue. The added claims cure the error pointed out by applicant as existing in the originally issued patent by setting forth a "storage medium" rather than a "magnetic medium", thereby covering mediums other than magnetic such as, for example, an optical medium. However, it is noted that the original disclosure always specifies that the medium is a magnetic medium and provides no indication that medium could be of any other type. The

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added claims as a result are directed to a range of subject matter which would include subject matter not disclosed in the original patent.

5. Claims 1 to 42 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. Claims 19 to 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 19 to 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 19 to 42 set forth a storage medium rather than a magnetic medium and as a result would cover mediums such as an optical medium, an aspect for which the original disclosure does not provide support for.

7. Claims 22, 28, 34, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 sets forth that the data storage card is substantially rectangular but this would appear to contradict claim 21 from which claim 22 depends and which

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sets forth that the data card is shaped as one of a polygon, ellipse, or circle. A similar problem exist for claims 28, 34, and 40.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 19-22, 24-26, 28, 30-34, 36-38, 40, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (U.S. 5,579,296). Smith discloses a data card to be read by a standard CD player wherein the card is rotated about an axis perpendicular to and passing through the data card. The card may be interpreted to take the first form of a thin film data carrier which is temporarily removed from a support sheet and received onto an adaptor to thereby form the data card, or interpreted to take the second form wherein the thin film data carrier is permanently affixed to a card to thereby form the data card which is placed into an adaptor. In the first form the data card includes the adaptor while in the second form the data card can or cannot include the adaptor in reading on the claims. The data card includes visual information thereon and optically encoded digital data to be read by the CD player. In the first form the data card stores

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information over the entire area of the data card. In the first form the data card is circular while in the second form the data card is rectangular.

10. Claims 19, 22-25, 28-31, 34-37, 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo (U.S. 4,916,687). Endo discloses a rectangular data card which may have visual information and optically encoded information thereon. The data card is receivable in a drive which rotates the data card about an axis perpendicular to the data card and which passes through the data card. The data card includes curved outer edge portions 13, 15 which are used for alignment purposes.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al or Endo. Neither reference expressly discloses having the data card take the form of a polygon or ellipse.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the data card of Endo or Smith to be a polygon or an ellipse. The motivation would have been: one of ordinary skill in the art would have recognized that utilizing a shaped space in

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an adaptor (Smith) or a turn table (Endo) would have allowed freedom of shape as the shaped space could be made to conform to the desired shape of the card, and Smith sets forth an awareness of utilizing various desired shapes at column 9 - line 66 to column 10 - line 10.

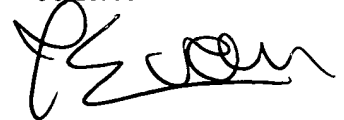
13. Claims 1 to 18 are allowable over the prior art of record but have been rejected as being based upon a defective reissue declaration under 35 U.S.C. 251, as set forth in paragraph 5 of this office action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferson Evans, whose telephone number is (703) 308-1610. The examiner can normally be reached on Monday to Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen, can be reached at (703) 305-9687. The facsimile number for this art unit is (703) 872-9314. Tech Center 2600 customer service office phone number is (703) 306-0377.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Jefferson Evans



August 22, 2001

**JEFFERSON EVANS
PRIMARY EXAMINER**